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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,685	01/11/2002	Peter Ar-Fu Lam	B7HTAG	9707

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EXAMINER	
FIDEI, DAVID	

ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/044,685	LAM, PETER AR-FU	
	Examiner	Art Unit	
	David T. Fidei	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-6 and 8-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *10-21* is/are allowed.

6)☒ Claim(s) *1,4 and 22-24* is/are rejected.

7)☒ Claim(s) *5, 6, 8, 9* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 January 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Harmer et al (Patent no. 5,135,141). A garment hanger retail package is disclosed comprising: at least one garment hanger 10 having a suspension member 12 and two support arms 16, 18 extending from opposite directions of said suspension member for supporting a garment configured to provide a smooth support for the corresponding shoulder portion of a garment; and a display tag 22 having a display area 26 positioned substantially vertically above one or both of said supporting arms for displaying sales information related to said garment hanger, see figures 1-3.

As to claim 22 a first display region is defined in the space positioned vertically above the first support arm, a space positioned vertically above the medial portion defining a second display region and a space positioned vertically above the second support arm defines a third display region. The display tag 22 of Harmer et al is disclosed as positioned on top of the first display region as shown in the embodiments of figures 2 & 3 where the first display region is the right support arm shown in the figure.

3. Claims 1, 4, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Markman (Patent no. 5,962,834). A garment hanger retail package is disclosed comprising: at least one garment hanger having a suspension member and two support arms (not numbered) extending from opposite directions of said suspension member for supporting a garment configured to provide a smooth support for the corresponding shoulder portion of a garment; and

a display tag 10 having a display area 12 (or any other portion) positioned substantially vertically above one or both of said supporting arms for displaying sales information related to said garment hanger.

As to claim 4, the display tag 10 further comprising a flap 14 having a hole 16A for engaging the suspension member of said garment hanger.

As to claim 22, the display tag 10 of Markman is shown as positioned on top of the third display region as shown in figure 1.

As to claim 23, a display tag positioned behind said garment hanger enabling said retail package to display a full frontal view of said garment hanger depends upon the perspective as the hanger of figure 1 can be rotated 180 degrees.

4. Claims 1, 4 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Rahmey (Patent no. 6,209,763). A garment hanger retail package is disclosed comprising: at least one garment hanger 40 having a suspension member and two support arms 42, 44 extending from opposite directions of said suspension member for supporting a garment configured to provide a smooth support for the corresponding shoulder portion of a garment; and a display tag 60 having a display area 62 positioned substantially vertically above one or both of said supporting arms for displaying sales information related to said garment hanger.

As to claim 4, the display tag further comprises a flap defined by folded section 70 having a hole 72, see figure 4.

As to claim 22, the display tag surface 64 of Rahmey shown in figure 3 has a front facing display area positioned on top of the first and third display regions with respect to garment hanger 40.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Markman (Patent no. 5,962,834). The difference between the claimed subject matter and Markman resides in the attaching means are defined by one or more fasteners having a color similar to the color of said garment hanger. Dictionary.com defines a fastener as restraint that attaches to something or holds something in place that is met by the grommet 16 of Markman. However, the relative colors of the grommet and garment hanger are not disclosed.

However the particular color is of no patentable significance because the particular shape fails to solve any stated problem or is for any particular purpose. Accordingly, it would have been obvious and well within the level of ordinary skill in the art to construct the fastener and garment hanger of any color desired, for the reason that such a change is of no criticality and would have merely been a matter of design choice.

Allowable Subject Matter

7. Claims 5, 6, 8, 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 10-21 are allowed.

Drawings

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "227" has been used to designate both a display tag flap (page 8, lines 22 and 26 are not consistent) and the clips of a pants bar (page 9, lines 9-11 of the present specification).

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance

Response to Arguments

10. Applicant's arguments filed June 15, 2005 have been fully considered but they are not persuasive.

The amendment by Applicant emphasizes the garment hanger "for supporting a garment having two shoulder portions, wherein the top surface along each support arm is configured to provided (sic) a smooth support for the corresponding shoulder portion of said garment". With regard to the garment hanger of Harmer, these hangers can be discarded at the time of sale, returned to the garment manufacturer or provided to the consumer, see col. 1, lines 25-28. While Applicant strenuously argues retail hangers are the subject matter to which claims 1 and 22 are directed, it is difficult at best to draw a distinction on this basis.

Applicant argues;

> "Store use display hanger and consumer use hangers are very different business well known to any people in the garment hanger profession. It is well known to the garment hanger industry that store use hangers and consumer use retail hangers are completely different businesses provided by different manufacturers, and distributed through different channels."

page 8 of response. However, the way hangers are distributed has nothing to do with any characteristics of the hanger per se, much less any distinguishing features related to the hanger. How can one distinguish a "retail" hanger over the hanger of Harmer et al based on the definition that retail hangers are for independent resale? It's not the Examiner does not understand applicant's perspective, but that this definition (of retail hangers) does not form a basis for defining patentable features differentiating the hangers. Could one not resale the hangers of Harmer et al directly to the consumer? Particularly, after they are gathered as Harmer et al describes? Or even from another perspective, the hangers of Harmer et al are stated as given away. Presumably, having a resale value of zero.

While Harmer et al does state the hanger may be formed with suitable grips or clip members to enable the gripping attachment of various kinds of garments thereto, such as underwear, slips, brassieres, multiple garments, and the like, col. 1, lines 37-41, this appears to be equivalent to the retail hanger type in figure 5 of the present invention. Again, evidencing the difficulty in distinguishes between hangers based upon retail use. Also, it appears applicant neglected Harmer et al col. 4, lines 52-54 where it is stated the hanger construction "may be of a simple rounded end configurations to merely permit hanging suspension of a garment". Hence, it is submitted Harmer et al clearly discloses two support arms extending from opposite directions of said suspension member for supporting a garment configured to provide a smooth support for the corresponding shoulder portion of a garment as claimed.

35 U.S.C. 102 (b)

11. The Examiner realizes it is a fundamental tenet of patent law that the standard for anticipation is one of strict identity. To anticipate a claim for a patent, a single prior art reference must contain all of the elements recited in the claim.

"An anticipation rejection requires a showing that each limitation of a claim must be found in a single reference, practice or device." *In re Donohue*, 766 F.2d 531, 266 USPQ 619, 621 (Fed. Cir. 1985).

"Exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference." *Atlas Powder Company v. E.I. du Pont De Numours*, 750 F2.d 1569, 1574, 224 USPQ 409, 411 (Fed. Cir. 1984).

However, the law of anticipation does not require that the reference teach what applicant has disclosed, but only that the claims "read on" something disclosed in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 281 USPQ 871 (Fed. Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of the claim as a reference must disclose the claimed subject matter expressly or inherently, *Constant v. Advanced Microwave Devices, Inc.*, 7 USPQ2d 1057 (Fed. Cir. 1989).

The fact that claim 1 recites, as argued by applicant, a retail hanger where the display area is to display information RELATED TO SAID HANGER results in no patentable moment. Claim 1 specifically calls for "a display tag having a display area positioned substantially vertically above one or both of said supporting arms *for* displaying sales information related to said garment hanger" (emphasis added). This is a statement of intended use. In order to further limit the claim there must be some distinction based upon the intended use recited. "However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art, see M.P.E.P. § 2111.02. The examiner can see no structural differences between the claimed invention and the prior art based upon the intended use recited.

Secondly, Harmer et al includes indicia 22 is provided to display sizes of a retail garment, or the Logo of the retail store/garment manufacturer, or the designer of the retail garment. Any distinction regarding the specific type of display employed is also of no patentable moment. In order for such "printed matter" to distinguish the invention from prior art, in terms of patentability, the printed matter must be functionally related to the substrate in order to be entitled patentable weight.[i] In the present case the specific display sales information does not interrelate with the package in the way the indicia interrelated with the band of Gulack's invention. In the present instant the retail display indicia does not depend upon the package and the package does not depend upon the printed matter. All the specific display, or printed matter, does is provide a different use of an existing product. Accordingly, the printed matter is of no patentable distinction.[ii]

As to a store use hanger being so vastly different from a retail garment hanger that the distinguishable characteristic is well known to any person having ordinary skill in the different arts, this is not seen as the case. As noted in paragraph 10 above, if such were the case then it would be a simply matter to define one over the other. However, the hangers basically function in the same way. To hold garments. Accordingly the rejection of claim 1 under 35 U.S.C. 102(b) over Harmer et al is respectfully maintained.

As to Applicants request that the Examiner review for the "proper" interpretation of the term -vertically above-, it is now evident the amendment to the specification submitted 02/25/2005 where the use of the term to avoid the region positioned vertically above the medial portion, as indicated in the region 201, 202 of the display tag 200 of Figure 4, constitutes new matter. It is not seen where the specification, as originally filled, conveyed that vertically above is constrained to the meaning now reviewed.

12. The amendment filed 02/25/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

"The term "vertically above" is important in the interpretation of the subject disclosure. A display region positioned "vertically above" a hanger support arm is defined to be the display areas 207 and 208 positioned vertically above the hanger support arms 225 and 226. For the avoidance of doubt, this display region does not include the region positioned vertically above the medial portion, as indicated in the region 201, 202 of the display tag 200 of Figure 4."

Applicant is required to cancel the new matter in the reply to this Office Action.

Furthermore, it is not understood how one can tenably maintain the Examiner has ignored the interpretation of vertically above, consistent with the present disclosure, yet acknowledge that the prior art reference by Harmer et al includes indicia vertically above as defined by the subject application. The point appears moot.

As to applicants request under MPEP 707.07(j), the Examiner suggests applicant amend the specification by canceling the text in paragraph 12 above, change the claims to incorporate the subject matter of claims 5, 6, 8, 9, see paragraph 7 above.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David T. Fidei
Primary Examiner
Art Unit 3728

dtf
August 31, 2005

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[i] In re Gulack, 217 USPQ 410 (CAFC 1983)

[ii] In re John Ngai and David Lin (CAFC, 5/13/2004), NONPRECEDENTIAL OPINION ISSUED March 8, 2004, PRECEDENTIAL OPINION ISSUED May 13, 2004.